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| 09/772,278 | 03/15/2001 | Robert Skvorecz | 4336 | 9274 |

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NEW YORK,, NY 10020-1182

EXAMINER

LE, TAN

| ART UNIT | PAPER NUMBER |
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3632

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/772,278

Applicant(s)

SKVORECZ, ROBERT

Examiner

Tan Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 6 is/are allowed.
6) ☒ Claim(s) 1-5 and 7 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is the fourth office action for application serial number 09/772,278.
2. This application is a reissue of application 09/005,787 filed January 12, 1998 now as Patent No. 5,996,948 which issued on December 07, 1999. This reissue application contains 7 claims numbered 1-7. New claim 7 has been added which recites the limitations omitted from claim 1.
3. Applicant's submission of Supplemental Reissue Declaration by the Patentee on 08/06/04 is acknowledged. The Supplemental Reissue Declaration by the Patentee appears to be fulfilled the requirements of section 1.63.
4. Reissue claim 2 and claim 7 have now been corrected in the manner required by 37 CFR 1.121. Applicant points out that under the new rules, new claims are not supposed to be underlined. This is not corrected. Under the revised amendment practice: 37 CFR 1.121 for reissues and reexamination proceedings, except for drawings, has not changed.

Recapture

Pursuant to the guidelines on pages 1-2 of the Memorandum of the Patent Office about Applying Recapture Rule to Reissue Applications dated August 4, 2003:

5. The Test: Three step process (Pannu)

First step: Determine whether, and in what aspect(s), the reissue claims are broader than the patent claims:

In the present reissue application, Applicant seeks to delete from patent claim 1 including the language underlined below to enlarge the scope of claim 1 of the patent, and to include it in a new dependent claim 7. The deletion of "a lower rim of wire steel forming a closed geometrical configuration circumscribing a second surface area with said first surface area being larger than said second surface area" (lines 5-10); the deletion of "at a location below the lower rim" (lines 14-15); and the deletion of "and to said lower rim at a relatively equal distance below the point of attachment to said upper rim" (lines 24-27) thus broaden the scope of the reissue claim 1 as a result of the deletion of the above limitations.

Second step: Determine whether the broader aspect (s) of the reissued claims relate to surrendered subject matter.

The examiner has reviewed the patent file as to the changes made in the claims. An amendment was filed on July 26, 1999 after a first rejection. The amendment filed on July 26, 1999 (Paper No. 3 in the patented file) made changes to the independent claim 1 which involved changing from [a pair of wire legs of equal length affixed at one end thereof to the upper rim and affixed to the lower rim at an equal location substantially approximate the opposite end of each wire leg such that the upper rim and lower rim lie in substantial parallel alignment to one another with the wire legs extending equal distances below the lower rim to uniformly support the stand at opposing ends thereof and having a plurality of offsets in the upper rim of said stand or in the wire legs at the point of interconnection therebetween] to – a plurality of wire legs with each wire leg having two upright sections interconnected to one another at a location below the lower

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rim in a configuration forming a base support for the stand to rest upon with each upright section extending upwardly from said base support to form an angle equal to or greater than 90 degrees with respect to a horizontal plane through said base support and being affixed to the upper rim adjacent one end thereof and to said lower rim at a relatively equal distance below the point of attachment to said upper rim and further comprising a plurality of offsets located either in said upright sections of said wire legs or in said upper rim for laterally displacing each wire leg relative to said upper rim to facilitate the nesting of a multiplicity of stands into one another without significant wedging--.

Changes to claim 1 were made by Applicant in an effort to make claim 1 narrower and to overcome the prior art rejection in order to make the claim 1 allowable. These changes are deemed surrendered and given up during the prosecution of the original application to overcome an art rejection.

In addition to the changes above, Applicant also made an statement on the record that "Applicant has amended Claims 1 and 5 to clearly distinguish the subject invention from the disclosure in Andrews (US 1,688,846) (See page 4, lines 3-4 of the amendment filed on July 26, 1999); and "additionally, claim 1 requires each wire leg to have two upright sections which are interconnected to one another at a location below the lower rim in a configuration forming a base support for the stand to rest upon" (see page 4, lines 11-13 of the amendment filed on July 26, 1999).

Applicants in the reissue claim has now attempted to modify those changes by deleting one of those limitations in the reissue claim 1 providing a broadening aspect

relates to surrendered subject matter that Applicant previously surrendered. This is sufficient to establish a rejection on recapture ground.

Third step: Determined whether the reissued claims were materially narrowed in other aspects to avoid recapture rule: None of the language has been found in the reissued claims that were materially narrowed in other respects to avoid the recapture rule.

Recapture Baseline set by MPEP 1412.02.

6. As pointed out in MPEP 1412.02, a patentee cannot recapture, in a reissue application, claims that are of (a) an equal scope, or (b) a broader scope, than the claim subject matter "canceled" from the original application in favor of more specific claims, in order to overcome an art rejection. (The "cancellation" of claim subject matter can be by deleting the claim and substituting a narrower claim, or by amending the existing claim so that it becomes narrower). As further pointed out in MPEP 1412.02, surrender can occur through argument alone (without claim amendment in the application)- "surrendered subject matter" will be considered to have "crept into the reissue claim" where the patentee presents in the reissue application a claim that excludes the claim limitation(s) which Applicant had argued to distinguish over the art in obtaining the patent.

7. Claims 1-5 and 7 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the

patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984).

The record of the original application shows that the broadening aspect in the reissue claim 1 relates to subject matter that Applicant previously surrendered during the prosecution of the application as pointed out in the above rejection. The narrow scope of the claim 1 in the parent patent is not an error within the meaning of 35 U.S.C. 251. Therefore, the broader scope surrendered in the reissue parent application cannot be recaptured by the filing of the present reissue application. This rule has been recently reiterated by the Court in *Pannu v. Storz Instruments Inc.*, 59 U.S.P.Q. 2d 1597 (CAFC 7/25/01).

Claim Rejections - 35 USC § 102

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,503,062 to Buff, IV.

Regarding claim 1, Buff, IV discloses a wire support (Fig.2) comprising a first rim (40) of wire steel which forms a closed geometrical configuration circumscribing a first surface area, and having at least two wire legs (49, Fig. 2) with each wire leg having two upright sections interconnected to one another in a configuration forming a base support

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for the stand to rest upon with each upright section extending upwardly from the base support to form an angle greater than 90 degrees with respect to a horizontal plane through the base support and being affixed to the first rim adjacent one end thereof, and further comprising a plurality of offsets (52) located either in the upright sections of the wire legs or in the first rim for laterally displacing each wire leg relative to the first rim. The offsets can facilitate the nesting of a multiplicity of stands into one another without significant wedging (see Col. 5, lines 13-16 and lines 30-34).

Regarding claim 2, Fig. 2 of Buff, IV also shows the plurality of offsets (52) being in the upright section and divided each upright section into two sections lying in different planes relative to one another.

Regarding claim 5, Fig. 2 of Buff, IV also appears to show the plurality of offsets being welded or coupled to the wire legs at the separation (separation between the legs and the handle 38) of the upright section into segments. Nevertheless, referring to the process step such as welding is not accorded patentable weight in the product-by-process claim. It is well settled that the patentability of a product does not depend on its method of production. Product -by-process claims are not construed as being limited to the product formed by the specific process recited. In re Hirao et al., 535 F2d 67, 190 USPQ 15.

Allowable Subject Matter

9. Claim 6 is allowed.

Response to Arguments

10. Applicant's arguments filed 08/06/04 have been fully considered but they are not persuasive.

In response to applicant's argument "that the wire chafing stand of the subject reissue application does not employ or contemplate an assembly which requires the use of an internal rack 12. Moreover, if such an internal rack 12 were used, it would prevent the offsets claimed in claims 1, 2 and 5 from facilitating the nesting of stands into one another without wedging as claimed..." as presented on pages 2 and 3 of the Remarks, it is noted that the features upon which applicant relies (i.e., internal rack) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that "...technically impossible to facilitate the nesting of a multiplicity of stands into one another based upon the teaching of Buff IV'062" as presented on page 3, second paragraph. This is not found persuasive. Buff IV stand clearly shows a plurality of offsets located either in said upright section of said wire legs or in said first rim for laterally displacing each wire leg relative to said first rim. Contrary to Applicant's argument, the examiner respectfully submits that Buff IV structure is clearly well met and satisfying all the claimed structural limitations. Buff IV stand is capable of facilitating a multiplicity of stands into one another without significant wedging.

Applicant's argument with respect to the recapture is well taken. However, the examiner still remains his position as pointed out in the office action.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tan Le whose telephone number is (703) 305-8244. The examiner can normally be reached on Mon. through Fri. from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leslie Braun can be reached on (703) 308-2156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tan Le
Patent examiner
December 23, 2004.



ANITA KING
PRIMARY EXAMINER